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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,021	02/26/2004	Kristin Feeley	12712/46101	2923
23838	7590	03/23/2006	EXAMINER	
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			WILLIAMS, CATHERINE SERKE	
			ART UNIT	PAPER NUMBER
			3763	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/786,021

Applicant(s)

FEELEY ET AL.

Examiner

Catherine S. Williams

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6,9-11,13 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,8,12 and 14-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/6/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

It is noted that claim 10 depends from claim 9 (withdrawn in the previous office action) which is drawn to a non-elected invention. Claim 10 was examined in error in the previous office action and should have also been withdrawn since it depends from a withdrawn claim. Correction is now made and the claim is hereby withdrawn.

Claim Objections

Claims 1-5, 7-8, 12 and 14-19 are objected to because of the following informalities: claims 1 and 18 both recite "detaches the intervention device from the delivery system" which is not consistent with the claims, specification and drawings. According to claims 1 and 18, the delivery system comprises an intervention device, a hub and a delivery tube. Therefore, the new claim language recites detaching the intervention device from itself. A more accurate recitation would be --detaches the intervention device from the delivery tube—which would be consistent with the claim language, specification and drawings. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-5, 8, 12 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hochman (USPN 6,726,658) in view of Utterberg et al (USPubN 2003/0175323). Hochman discloses an intervention rod (94), a hub (92), and a delivery tube (12) where longitudinal movement of the hub by a connected extension arm (100, 50, 80, 82 and 84) and finally a clinician (see 52-53) ejects the intervention rod from the delivery tube (12) and detaches the rod from the delivery tube. See figures 1-4. The tube has a continuous slit longitudinal partition (24) and hub opening (32) which allows access to the hub via the exposed portion of extension arm (100). The arm and hub have a tapered connection point (84, 92) that enables removal. See figures 3-4. The hub has an aperture. See figure 10. A valve (22) is coupled to an open end of the delivery tube. The method steps of coupling, forming, and disposing are considered inherent in order to properly make and use the device as disclosed.

Hochman meets the claim limitations as described above but fails to include the rod being an antimicrobial bearing device. However, Utterberg discloses a catheter/rod that includes iodine. The iodinated catheter/rod is designed with the antimicrobial treatment in order to reduce problems with infection. See paragraph 0002.

At the time of the invention, it would have been obvious to incorporate the teaching of a antimicrobial iodine into the invention of Hochman. Both devices are analogous in the art of percutaneous administration into a patient; therefore, a combination is proper. Additionally, the motivation is provided in that Utterberg teaches an enhanced design for reduced infection in a patient and the incorporation of the iodine into the rod (94) of Hochman would have been in order to provide the patient with enhanced safety from infection.

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Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hochman in view of Utterberg. Hochman in view of Utterberg meets the claim limitations as described above but does not teach a perforated partition.

At the time of the invention, it would have been an obvious design choice to make the slit of Hochman in view of Utterberg as a perforated slit. Applicant has failed to establish that the perforated slit provides an advantage, is used for a particular purpose or solves a stated problem. Furthermore, one would expect a continuous slit or a perforated slit to perform equally well considering that either slit would enable the rod to be advanced toward a patient and detached from the delivery tube.

Claims 14-16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hochman in view of Utterberg in further view of Chang et al (USPN 5,419,766). Hochmann in view of Utterberg meets the claim limitations as described above but fails to include the delivery tube being made from a polyester.

However, Chang discloses polyester sheaths. The material is used for its hydrophobic property to prevent moisture from traveling through the sheath. See 7:35-62.

At the time of the invention, it would have been obvious to incorporate the material, i.e. polyester, as taught by Chang to make the delivery tube of Hochmann in view of Utterberg. The devices are analogous in the art of percutaneous administration; therefore, a combination is proper. Additionally, the motivation is provided by Chang in that the material prevents moisture from traveling through the sheath. One skilled in the art would reasonably conclude that by

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preventing the transmission of moisture through the tube one would enhance the sterility of the device prior to use thereby enhancing the safety to the patient.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine S. Williams whose telephone number is 571-272-4970.

The examiner can normally be reached on Monday - Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas D. Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Catherine S. Williams
March 20, 2006